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Paper No. 5

TROPIAN INC.  
20813 STEVENS CREEK BLVD.  
CUPERTINO CA 95014

COPY MAILED

OCT 03 2002

OFFICE OF PETITIONS

In re Application of :  
Nigel J. Tolson :  
Application No. 10/040,535 : DECISION REFUSING STATUS  
Filed: 28 December, 2001 : UNDER 37 CFR 1.47(b)  
Attorney Docket No. 111228TWT.US :

This is in response to the petition filed on 12 August, 2002,  
under 37 CFR 1.47(b).

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of  
this decision to reply, correcting the below-noted deficiencies.  
Any reply should be entitled "Request for Reconsideration of  
Petition Under 37 CFR 1.47(b)," and should only address the  
deficiencies noted below, except that the reply may include an  
oath or declaration executed by the non-signing inventor.  
**FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.**  
Extensions of time may be obtained in accordance with 37 CFR  
1.136(a).

The above-identified application was filed on 28 December, 2001,  
without an executed oath or declaration.

Accordingly, on 5 February, 2002, Initial Patent Examination  
Division mailed a Notice To File Missing Parts of Nonprovisional  
Application requiring an executed oath or declaration and a  
surcharge for its late filing.

In response, on 12 August, 2002 (certificate of mailing date 6  
August, 2002), the present petition was filed, accompanied by the  
late filing surcharge, and a four (4) month extension of time.

Petitioner asserts that the inventor has refused to sign the

declaration.

A grantable petition under 37 CFR 1.47(b) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a statement of the last known address of the non-signing inventor;

(5) proof of proprietary interest, and

(6) proof of irreparable damage.

The petition lacks items (1), (2), and (6).

In regards to item (1), petitioners must supply proof that a copy of the application (specification including claims, drawings, if any, and the declaration) was sent or given to the non-signing inventor for review.<sup>1</sup> Petitioners should submit a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign can be alleged, petitioners must show that the application papers were sent or given to the non-signing inventor. If the inventor refuses to sign the declaration in writing after being sent or given the application, a copy of that written refusal should be supplied with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 has not been presented. The oath or declaration must be signed by an officer of the corporation (president, vice president, secretary, or treasurer) on behalf of and as agent for the non-signing inventor(s). The officer must identify his/her title in the declaration, as well as his/her mailing address, residence, if the applicant lives at a different location from where he or she customarily receives mail, as well as the citizenship of individual signing on behalf of the non-signing inventor. If the oath or declaration is not

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<sup>1</sup>MPEP 409.03(d).

signed by an officer of the corporation, then proof of authority of the person signing on behalf of the corporation must be submitted.<sup>2</sup>

As to item (6), petitioners must provide a statement that the filing is necessary to prevent irreparable damage or to preserve the rights of the parties.<sup>3</sup>

Although petitioners submitted a request for a four (4) month time extension, counsel's deposit account was inadvertantly charged for a five (5) month extension of time. However, since the transmittal sheet accompanying and itemizing the filing of the petition and time extension request contains a valid certificate of mailing dated 6 August, 2002, only a four (4) month extension of time is required. The different will therefore be credited to counsel's deposit account, No. 50-1788.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
2201 S. Clark Place  
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703)308-6918.

  
Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>2</sup>MPEP 409.03(b).

<sup>3</sup>MPEP 409.03(g).